

REMARKS

Claims 11-30 are pending in this Application. By this Response, Applicants have amended claim 11. Accordingly, claims 11-30 are at issue. Applicants respectfully submit no new matter was added by these amendments.

Applicants have amended the Related Applications section of the application to correct a typographical error in the identification of the patent granted for Application No. 09/166,870.

The Examiner has rejected claims 11-21, 24-29 and 31 under 35 U.S.C. 103(a) as being unpatentable over Salas in view of Hershey. Applicants respectfully traverse this rejection.

Claim 11, as amended herein, is directed to a network communication system comprising "a master device for initiating a request message" and "a slave device being exclusively responsive to the request message of the master device for providing a response message." The system of claim 11 further requires "an optimal protocol utilized to communicate the request message and the response message between the master and slave devices."

The Examiner relies only on Salas for the rejection of claim 11. However, contrary to the Examiner's position, none of the portions of Salas specifically cited by the Examiner disclose all of the limitations of claim. For example, Salas fails to disclose "a slave device exclusively responsive to the request message." In arguing this limitation is obvious in view of Salas, the Examiner attempts to explain

... Salas discloses a configuration functionality wherein it would have been obvious to configure exclusive relationships between network components providing notification for the same as needed. Specifically, Examiner note that a slave device obviously requires knowledge of its master device, which knowledge would be included within communication parameters set up during configuration. (Office Action of December 6, 2004, pp. 2-3).

However, the Examiner fails to establish why "it would have been obvious to configure exclusive relationships" or how the slave device's "knowledge of its master device" leads to such an exclusive

relationship. In the absence of the disclosure of this limitation in Salas, it is the Examiner's burden to show some incentive or motivation in the prior art for modifying Salas in the manner proposed. The Examiner has failed to make this showing.

Similarly, the portions of Salas cited by the Examiner (i.e., "Col. 6, lines 5-45"), fail to disclose "an optimal protocol utilized to communicate the request message and the response message." Instead, this portion appears to only deal with a standard protocol, and fails to refer to or suggest any "optimal" protocol for the communications.

Accordingly, Applicants respectfully submit claim 11 is patentable over Salas in view of Hershey. Claims 12-21 depend on claim 11, either directly or indirectly, and include each of its limitations. Therefore, Applicants respectfully submit claims 12-21 are also patentable over Salas in view of Hershey.

Claim 24 is directed to an Ethernet module having "an Ethernet controller," "a control processing unit," and "an optimal communication stack." Claim 24 requires the optimal communication stack include "an application layer protocol using a state machine."

The Examiner acknowledges Salas does not describe "optimizing a MODBUS/TCP/IP stack with a 'finite state machine'" and relies on Hershey for disclosure of the uses of a finite state machine for performance optimization. However, the Examiner fails to properly show any incentive or motivation in the prior art to make the proposed combination of elements.

The Examiner cites from Hershey to maintain the "motivation to substitute the optimized MODBUS/TCP/IP stack of Salas with the finite state machine of Hershey is to provide an architecture and method for applying a real time feedback control to the logical or physical network behavior of a complex data communications network, (Hershey, Col. 3, lines 48-51)." (Office Action of December 6, 2004, pp. 3-4). However, this "object" of Hershey fails to provide any motivation for the proposed substitution. The goal of providing an architecture for applying real time feedback fails to suggest or make any reference to providing an "optimal communication stack" as required by claim 24. Moreover, there is no suggestion in Hershey that the state machine is

utilized in connection with an application protocol in the manner required by claim 24.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Here, there is absolutely no incentive in the cited references to combine the references in the manner suggested by the Examiner. When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP 2143.01. Second, there must be a reasonable expectation of success. See MPEP 2143.02. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. See MPEP 2143.03. The teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner bears the initial burden on factually supporting any *prima facie* conclusion of obviousness. See MPEP § 2142. In the present case, the Examiner failed to meet this burden.

It is apparent the Examiner took isolated features from the cited references, and has used the claims of the present application as a template. Such hindsight reconstruction is improper. It is well-recognized that the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art in an attempt to render the claimed device obvious. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); *Fine*, 837 F.2d at 1075 ("one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed

invention.”).

Accordingly, Applicants respectfully submit claim 24 is patentable over Salas in view of Hershey. Claims 23-29 and 31 depend on claim 24, either directly or indirectly, and include each of its limitations. Therefore, Applicants respectfully submit claims 23-29 and 31 are also patentable over Salas in view of Hershey.

The Examiner has rejected claims 22, 23 and 30 under 35 U.S.C. 103(a) as being unpatentable over Salas in view of Hershey in further view of Friedman. Applicants respectfully traverse this rejection.

Claims 22 and 23 depend from claim 11, either directly or indirectly, and include each of its limitations, and 30 depends from claim 24 and includes each of its limitations. As set forth above, Applicants respectfully submit claims 11 and 24 are patentable over Salas in view of Hershey. Friedman does not cure the deficiencies of Salas and Hershey. Accordingly, Applicants respectfully submit claims 22, 23 and 30 are patentable over Salas in view of Hershey and further in view of Friedman.

Atty Docket No. SAA-5-2 (402P273)
U.S. Application No. 10/003,123
Filed: November 26, 2001

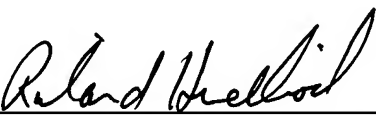
Page 11

CONCLUSION

In light of the foregoing reasons, Applicants respectfully request reconsideration and allowance of claims 11-31. The Commissioner is authorized to charge any additional fees or credit any overpayments associated with this Amendment to Deposit Account 23-0280. Applicants further invite the Examiner to contact the undersigned representative at the telephone number below to discuss any matters pertaining to the present Application.

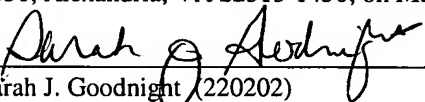
Respectfully submitted,

Date: March 4, 2005

By: 
Richard C. Himelhoch, Reg. No. 35,544
Customer No. 46901
WALLENSTEIN WAGNER & ROCKEY, LTD.
311 South Wacker Drive, 53rd Floor
Chicago, Illinois 60606-6604
(312) 554-3300

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on March 4, 2005.


Sarah J. Goodnight (220202)